

**REMARKS**

This request for reconsideration is filed in response to the Office Action dated July 25, 2008. In view of these remarks, this application should be allowed and the case passed to issue.

Claims 1-8 are pending in this application. Claims 1-8 were rejected.

***Claim Rejections Under 35 U.S.C. § 103(a)***

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuki et al. (US 5,409,764) in view of Murata et al. (US 5,563,236) (Murata et al. ('236)). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested. The following is a comparison between the present invention, as claimed, and the cited prior art.

The Examiner asserted that Otsuki et al. disclose a polyester resin comprising a polyester oligomer and an adhesive polymer, wherein the polyester oligomer comprises a compound having a hydroxyl group and an epoxide. The adhesive polymer may comprise a tackifier, which includes rosins and modified rosins. The adhesive polymer may also include an isophthalate, and the epoxide includes glycidyls with unsaturated substitution. The Examiner indicated that Otsuki et al. fail to disclose the use of an isocyanate crosslinking component having three or more functional groups. The Examiner relied on the alleged teaching of Murata et al. ('236) that sorbitol and isocyanates crosslinking agents are functional equivalents.

Contrary to the Examiner's assertions, the combination of references do not suggest the polyester comprising disproportionated rosin and glycidyl ester of tertiary fatty acids, as required by claim 1. The rosin in Otsuki et al. is added to the composition of the polyester and the adhesive polymer, the rosin is not part of the polyester as required by the present invention. Further, the glycidyl with unsaturated substituents of Otsuki et al. is not a glycidyl ester of tertiary fatty acids, as a glycidyl ester of tertiary fatty acids contains alkyl (unsaturated)

substituents. In addition, Otsuki et al. teach a composition comprising a polyester oligomer (A) and an adhesive polymer (B). In other words, Otsuki et al. teach a mixture of two different components the polyester (A) and the adhesive polymer (B), not a polyester comprising disproportionated rosin, terephthalic or isophthalic acid, glycidyl ester of tertiary fatty acid, aliphatic diol, and a polycarboxylic acid or polyol, as required by claim 1. Furthermore, there is no teaching in Murata et al. ('236) that isocyanates and sorbitol are functionally equivalent, rather Murata et al. teach a curing agent comprising an isocyanate-terminated compound, such as a reaction product of an isocyanate compound and sorbitol. Sorbitol is not an isocyanate-terminated compound and is not functionally equivalent to isocyanate curing agents.

The use of the polyester resin according to the present invention ensures long-term good development in any environment and solves environmental problems caused by bisphenol A, as explained in the present specification. Additionally, the elimination of bisphenol A as an alcohol component provides unexpected and remarkable advantages in the reduction in true density of the resin and reduces the amount by weight of toners consumed.

Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). There is no suggestion in Otsuki et al. and Murata et al. to modify the adhesive composition of Otsuki et al. to provide a polyester resin for a toner wherein the polyester comprises disproportionated rosin and glycidyl ester of tertiary fatty acids, as required by claim 1, nor does common sense dictate the Examiner-asserted modification. The

Examiner has not provided any evidence that there would be any obvious benefit in making the asserted modification of Otsuki et al. See *KSR Int'l Co. v. Teleflex, Inc.*, 500 U.S. \_\_\_\_ (No. 04-1350, April 30, 2007) at 20.

The only teaching of a polyester resin for toner wherein the polyester comprises disproportionated rosin and glycidyl ester of tertiary fatty acids is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must not be based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuki et al. and Murata et al. ('236) and further in view of Sakai et al. (US 4,868,078). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner relied on Sakai et al. for the teaching of a toner comprising a polyester resin, a coloring agent, and a charge control agent. The Examiner concluded that it would have been obvious to use the composition of Otsuki et al. and Murata et al. in the toner of Sakai et al. because the polyester resins are similar and one would have had a reasonable expectation of success.

Claim 5 is allowable for at least the same reasons as claim 1, as Sakai et al. do not cure the above-noted deficiencies of Otsuki et al. and Murata et al. ('236). Claim 5 is further distinguishable because there is no suggestion in either Otsuki et al. or Murata et al. ('236) to use the polyester compositions as a resin binder in a toner. Otsuki et al. and Murata et al. ('236) are not analogous with Sakai et al. Claim 5 is directed to a toner and Sakai et al. disclose toner, while Otsuki et al. is directed to a curable adhesive composition and Murata et al. ('236) is directed to a coating composition. One of ordinary skill in this art looking to solve a problem

with toners would not be lead to the non-analogous teachings of Otsuki et al. and Murata et al. ('236).

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuki et al., Murata et al. ('236), and Sakai et al. and further in view of Matsumura et al. (US 4,968,575). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner relied on Matsumura et al. for allegedly teaching a toner with metal salt of aromatic hydrocarboxylic acid charge control agent (Bontron S).

Claim 6 is allowable for at least the same reasons as claims 1 and 5, as Matsumura et al. do not cure the deficiencies of Otsuki et al., Murata et al. ('236), and Sakai et al. In addition, as explained in the response filed April 10, 2008, Applicants submitted evidence that Bontron S is not a metal salt of aromatic hydrocarboxylic acid, rather it is an azochromium complex. Applicants respectfully request the Examiner withdraw this rejection or explain why it is believed that Bontron S is an aromatic hydrocarboxylic acid charge control agent.

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Otsuki et al., Murata et al. ('236), and Sakai et al. and further in view of Murata et al. (US 2002/0085851) (Murata ('851)). This rejection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner relied on Murata et al. ('851) for the teaching of a fixing belt which runs between a pressing roller and a heating roller.

Claims 7 and 8 are allowable for at least the same reasons as claims 1 and 5, as Murata et al. ('851) do not cure the above-noted deficiencies of Otsuki et al., Murata et al. ('236), and Sakai et al.

In view of the above remarks, Applicants submit that this case should be allowed and passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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